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10/713,158

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Yoshifumi Tanimoto

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EXAMINER

GAUTHIER, GERALD

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/713,158

**Applicant(s)**

TANIMOTO, YOSHIFUMI

**Examiner**

Gerald Gauthier

**Art Unit**

2614

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1, 2 and 4, 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al. (US 7,333,472 B2) in view of Bach Comeliussen. (US 2005/0193123 A9).

Regarding **claim 1**, Yang discloses a communication terminal device (column 1, lines 18-20) comprising:

means for establishing a connection by a call control protocol with a destination device designated by an Internet Protocol telephone number [a user interface of a corresponding IP terminal transmits ID codes, such as a phone number, a port number and an IP address, column 5, line 62 to column 6, line14];

means for requesting a presentation of a plurality of communication protocols which the destination device can support over the connection [according to IP terminal connection information and call control information based on H.323/MGCP/SIP protocol procedures are presented, column 5, lines 26-40].

Yang fails to disclose selecting one communication protocol which the communication terminal device can support.

However, Bach Comeliussen teaches means for selecting one communication protocol which the communication terminal device can support from communication protocols presented by the destination device as a response to the request by the means for requesting [The client initiates the communication by sending a "setup" message according to the standard call control protocol which has been selected, paragraph 0050]; and

means for communicating with the destination device over the connection by the communication protocol selected by the means for selecting [the suggested media set is accepted by the server by a message that also includes the media destination address to which the client is to send the media, paragraph 0050].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Yang using the teaching of selecting of communication protocol as taught by Bach Corneliussen.

This modification of the invention enables the system to select one protocol which the communication terminal device can support so that the user would use the data communication protocol of choice because the selecting of protocol would alleviate problems of operation and administration of multi-user in the system of networked computers.

Regarding **claim 2**, Yang discloses a communication terminal device, further comprising: means for storing a communication protocol and an IP telephone number by associating one with the other [The database 28 stores phone numbers and port numbers of legacy terminals 16, and subscriber information (i.e., phone numbers, port numbers, and IP addresses) of the IP terminals 18, column 4, lines 60-65];

wherein when a communication protocol is stored in the means for storing by being associated with the IP telephone number of the destination device, the means for requesting does not request a presentation of a plurality of communication protocols which the destination device can support over the connection [The exchange interface

30 receives call origination information transmitted from the IP terminals 18 connected to the hub 20, or transmits call termination information to the IP terminals 18, column 4, lines 60-67], and the means for selecting selects the communication protocol associated with the IP telephone number of the destination device and stored by the means for storing [The exchange interface 30 receives call origination information transmitted from the IP terminals 18 connected to the hub 20, or transmits call termination information to the IP terminals 18, column 4, lines 60-67].

Regarding **claim 4**, Bach Corneliusen teaches a communication terminal device, further comprising: means for outputting to a prescribed destination, information indicating a failure in a communication with the destination device, when the means for selecting fails in selecting a communication protocol [the suggested media set is accepted by the server by a message that also includes the media destination address to which the client is to send the media, paragraph 0050].

Regarding **claim 6**, Bach Corneliusen teaches a communication terminal device, wherein the plurality of communication protocols include a Simple Mail Transfer Protocol (SMTP) and a Hyper Text Transfer Protocol (HTTP) [a standardized protocol such as for example the Hyper-Text Transfer Protocol (HTTP), paragraph 0020].

Regarding **claim 7**, Yang discloses a communication terminal device, further comprising: means for storing a communication protocol and an IP telephone number

by associating one with the other; and means for operating by an operator [The database 28 stores phone numbers and port numbers of legacy terminals 16, and subscriber information (i.e., phone numbers, port numbers, and IP addresses) of the IP terminals 18, column 4, lines 60-65];

wherein stored contents of the means for storing can be edited, added, or deleted freely by a prescribed operation from the means for operating [The database 28 stores phone numbers and port numbers of legacy terminals 16, and subscriber information (i.e., phone numbers, port numbers, and IP addresses) of the IP terminals 18, column 4, lines 60-65].

#### ***Allowable Subject Matter***

5. **Claim 8** is allowed.
6. **Claims 3 and 5** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

7. Applicant's arguments filed June 10, 2008 have been fully considered but they are not persuasive. Pages 3-7 of the remarks below:

As to the merits of this case, the Examiner sets forth the following rejection:

claims 1-4, 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yang et al., USP 7,333,472, in view of Bach, US Patent Application No. 2005/193123.

This rejection is respectfully traversed.

Claim 1:

Independent claim 1 calls for means for requesting a presentation of a plurality of communication protocols which the destination device can support over the connection. With regard to these features of claim 1, the Examiner relies on the disclosure set forth in column 5, lines 26-40, of the Yang reference, and asserts that according to the IP terminal connection information and call control information based on H.323/MGCP/SIP protocol procedures are presented.

However, it is respectfully submitted that the Examiner is mischaracterizing the teachings of the Yang reference. More specifically, in column 5, lines 9-26, Yang discloses that the IP terminals 18 respectfully contain a user interface and a communication module, which are not shown in Fig. 1. The user information and the user IP interface information establish signal transmission/reception with the IP-PBX 14 over a LAN line via a hub 20. The communication module is connected to the IP network 12, and performs a VoIP function in compliance with one or more of the H.323, MGCP and SIP protocol procedures. In other words, it is respectfully submitted that Yang clearly discloses that the communication module contained in the IP terminal 18 is connected and performs a VoIP function in compliance with one or more of the protocol procedures H.323/MGCP/SIP. In other words, it is respectfully submitted that the communication module of the IP terminal 18 is able to perform a VoIP function over the IP network 12 in accordance with one of the protocol procedures H.323/MGCP/SIP. As such, it is respectfully submitted that since the communication module of the IP



terminal 18 has the capability of performing a VoIP function in accordance with one of the protocol procedures, H.323/MGCP/SIP, the IP terminal 18 does not need to request a presentation of a plurality of communication protocols which the destination device can support over the connection. In addition, in column 5, lines 35-40, Yang discloses that the IP driver 22 which is connected to the IP terminal 18 and the IP-PBX 14 via a hub 20 controls the IP end points of the IP terminals 18 according to IP terminal connection information and call control information based on the H.323/MGCP/SIP protocol procedures. In other words, it is respectfully submitted that the IP driver 22 controls the end points of the IP terminals 18 according to the IP terminal connection of the communication module of the IP terminal 18 according to one of the H.323/MGCP/SIP protocol procedures.

Accordingly, when the communication module of the IP terminal 18 performs a VoIP function in compliance with one or more of the H.323/MGCP/SIP protocol procedures, the IP driver 22 controls the end points of the IP terminal according to one or more H.323/MGCP/SIP protocol procedures.

In view of the above, it is respectfully submitted that the Yang reference clearly fails to disclose a means for requesting a presentation of a plurality of communication protocols which the destination device can support over the connection, since the communication module of the IP terminal 18 includes the capability of performing a VoIP function in compliance with one or more of the H.323/MGCP/SIP protocol procedures and the IP driver 22 controls the IP end points of the IP terminal 18 according to one or more of the H.323/MGCP/SIP protocol procedures performed in the VoIP function by the

communication module of the IP terminal 18.

Therefore, it is submitted that there is simply no need for the IP terminal 18 to request a presentation of a plurality of communication protocols which the destination device can support over the connection, since the communication module of the IP terminal 18 already has the capability of performing a VoIP function in compliance with one or more of the protocol procedures and the IP driver 22 merely controls the end points of the IP terminal 18 according to the one or more protocol procedures.

The Examiner also acknowledges that the Yang reference fails to disclose selecting one communication protocol which the communication terminal device can support. In other words, it is respectfully submitted that the Examiner acknowledges that the Yang reference fails to disclose the features of claim 1 regarding means for selecting one communication protocol which the communication terminal device can support from communication protocols presented by the destination device as a response to the request by the means for requesting.

In order to compensate for the above-noted drawbacks and deficiencies of the Yang reference, the Examiner relies on the disclosure in paragraph [0050] of the Bach reference regarding "the client initiates the communication by sending a 'setup' message according to the standard call control protocol which has been selected," (that is H.323/MGCP/SIP).

However, while Bach may disclose that a setup message can be initiated by a client according to either the H.323 or the SIP call control protocol, it is respectfully submitted that the selection of either of these call control protocols are not selected based on

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being presented by the destination device as a response to the request by the means for requesting, as called for in claim 1.

As such, even if the Yang and Bach references can be combined in the manner suggested by the Examiner, such combination would still fail to teach or fairly suggest the features of claim regarding means for requesting a presentation of a plurality of communication protocols which the destination device can support over the connections; and means for selecting one communication protocol which the communication terminal device can support from communication protocols presented by the destination device as a response to the request by the means for requesting.

After review the remarks, the examiner respectfully disagrees.

The prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference need not teach or suggest all the claim limitations. The examiner explained why the difference between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ko is cited for call processing message converter in Internet protocol telephony.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/  
Primary Examiner, Art Unit 2614

/GG/  
July 29, 2008